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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,872	03/29/2000	Nobuhiro Hoshi	35.G2564	6109

5514 7590 11/03/2004

FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2/3

<b>Office Action Summary</b>	Application No. 09/537,872	Applicant(s) HOSHI, ET AL.	
	Examiner Thai Tran	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-48 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 34-48 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 29 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Please include the new Art Unit 2616 in the caption or heading of any written or facsimile communication submitted after this Office Action because the Examiner, who was assigned to Art Unit 2615, will be assigned to new Art Unit 2616. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 34-48 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 34-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 5,727,060) in view of Mankovitz (US 6,760,537 B2).

Regarding claim 34, Young discloses a recording apparatus (Fig. 22A), comprising:

a memory (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67) that stores information of a plurality of channels receivable by a tuner of an external receiver, the information being sent from the external receiver to said memory;

a control unit (CPU 228 of Fig. 22A, col. 17, lines 57-67) that controls output of a signal to the external receiver, the signal designating a channel of the plurality of channels receivable by the external receiver, based on the information stored in said memory; and

a recording device (VCR 206 of Fig. 22A, col. 17, lines 57-67) that records a television signal sent from the external receiver in response to the channels designating output signal. However, Young does not specifically disclose that the control unit controls output of the signal from the recording apparatus to the external receiver.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 35, the combination of Young and Mankovitz also discloses all the claimed limitations as discussed in claim 34 above including that the memory is further stores information of a channel receivable by the cable (the cable-specific RAM memory 238 of Fig. 22A, col. 17, lines 37-44 of Young ) except for providing that the memory stores a channel receivable by an other tuner.

Mankovitz teaches that the VCR can receive television from two different tuners (the cable box 966 and the satellite receiver 986 of Fig. 33, col. 33, lines 51-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the additional satellite receiver 986 as taught by Mankovitz into Young's system in order to increase the number of television channels to be received or recorded.

Regarding claim 36, the combination of Young and Mankovitz discloses all the claimed limitations as discussed in claim 34 above except for providing that said other tuner is included in the recording apparatus.

Young also teaches in other embodiment (Fig. 22B) that the programmable TV tuner of the VCR can be used instead of the programmable TV tuner of the cable decoder (col. 17, lines 13-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the programmable TV tuner of the VCR instead of the programmable TV tuner of the cable decoder as taught by other embodiment of Young in order to reduce the size of the system by not using the cable decoder.

Regarding claim 37, the combination of Young and Mankovitz also discloses the claimed wherein the other tuner is included in an other external receiver (the satellite receiver 986 of Fig. 33 of Mankovitz, col. 33, lines 51-67).

Regarding claim 38, the combination of Young and Mankovitz discloses the claimed wherein said memory comprises a first memory (the schedule memory 232 of Fig. 22A of Young, col. 17, lines 45-56) that stores information of channels receivable by the external receiver and a second memory (cable-specific RAM memory 238 of Fig. 22A of Young, col. 17, lines 37-44) that stores information of a channel receivable by the other tuner.

Regarding claim 39, the combination of Young and Mankovitz discloses the claimed wherein said memory stores information of a program receivable by the external receiver (col. 17, lines 37-44).

Regarding claim 40, Young discloses a recording apparatus (Fig. 22A), comprising:

a memory (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67) that stores information of a plurality of programs selectable by an external receiver, the information being sent from the external receiver to said memory;

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a control unit (CPU 228 of Fig. 22A, col. 17, lines 57-67) that controls output of a signal to the external receiver, the signal designating a channel of the plurality of channels receivable by the external receiver, based on the information stored in said memory; and

a recording device (VCR 206 of Fig. 22A, col. 17, lines 57-67) that records a television signal sent from the external receiver in response to the channels designating output signal. However, Young does not specifically disclose that the control unit controls output of the signal from the recording apparatus to the external receiver.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 41, the combination of Young and Mankovitz also discloses all the claimed limitations as discussed in claim 40 above including that the memory is

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further stores information of a channel receivable by the cable (the cable-specific RAM memory 238 of Fig. 22A, col. 17, lines 37-44 of Young ) except for providing that the memory stores a channel receivable by an other external receiver.

Mankovitz teaches that the VCR can receive television from two different external receivers (the cable box 966 and the satellite receiver 986 of Fig. 33, col. 33, lines 51-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the additional satellite receiver 986 as taught by Mankovitz into Young's system in order to increase the number of television channels to be received or recorded.

Regarding claim 42, the combination of Young and Mankovitz also discloses the claimed wherein said memory comprises a first memory (the schedule memory 232 of Fig. 22A of Young, col. 17, lines 45-56) that stores information of programs selectable by the external receiver and a second memory (cable-specific RAM memory 238 of Fig. 22A of Young, col. 17, lines 37-44) that stores information of a program selectable by the other external receiver.

Regarding claim 43, Young discloses a method of controlling a recording apparatus (Fig. 22A), comprising the steps of:

referring to a memory (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67), which stores information of a plurality of channels receivable by an external receiver, and generating a signal designating a channel of the plurality of channels receivable by the external receiver;



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sending the channel designating signal to the external receiver (CPU 228 of Fig. 22A, col. 17, lines 57-67); and

recording a television signal sent from the external receiver to the recording apparatus in response to the channel designating signal (VCR 206 of Fig. 22A, col. 17, lines 57-67). However, Young does not specifically disclose that the channel designating signal is generated from the recording apparatus to the external receiver.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 44, Young discloses a method of controlling a recording apparatus (Fig. 22A), comprising the steps of:

referring to a memory (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67), which stores information of a plurality of programs selectable by an external receiver, and

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generating a signal designating a program of the plurality of programs selectable by the external receiver;

sending the program designating signal to the external receiver (CPU 228 of Fig. 22A, col. 17, lines 57-67); and

recording a television signal sent from the external receiver to the recording apparatus in response to the channel designating signal (VCR 206 of Fig. 22A, col. 17, lines 57-67). However, Young does not specifically disclose that the channel designating signal is generated from the recording apparatus to the external receiver.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 45, Young discloses a television signal receiving apparatus (Fig. 22A), comprising:

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a tuner (a programmable TV tuner of the cable decoder 202 of Fig. 22A, col. 17, lines 13-27); and

a control unit (CPU 228 of Fig. 22A, col. 17, lines 57-67) that controls the television signal receiving apparatus so as to send information of a plurality of channels receivable by the tuner to the television schedule system/tape controllers, and to send to the external recording apparatus a television signal of a channel of the plurality of channels designated by a control signal sent from the television schedule system/tape controllers to the television signal receiving apparatus. However, Young does not specifically disclose that the control signal is generated from the external recording apparatus to the television signal receiving apparatus.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 46, Young discloses a television signal receiving apparatus (Fig. 22A), comprising:

a tuner (a programmable TV tuner of the cable decoder 202 of Fig. 22A, col. 17, lines 13-27); and

a control unit (CPU 228 of Fig. 22A, col. 17, lines 57-67) that controls the television signal receiving apparatus so as to send information of a plurality of programs selectable by the tuner to the television schedule system/tape controllers, and to send to the external recording apparatus a television signal of a program of the plurality of programs designated by a control signal sent from the television schedule system/tape controllers to the television signal receiving apparatus. However, Young does not specifically disclose that the control signal is generated from the external recording apparatus to the television signal receiving apparatus.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young

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by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 47, Young discloses a method of controlling a television signal receiving apparatus (Fig. 22A), comprising the steps of:

sending information of a plurality of channels receivable by the television signal receiving apparatus to the television schedule system/tape controllers (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67);

selecting a channel of the plurality of channels designated by a control signal sent from the television schedule system/tape controllers to the television signal receiving apparatus (col. 17, lines 57-67); and

sending a television signal of the selected channel from the television signal receiving apparatus to the external recording apparatus (VCR 206 of Fig. 22A, col. 17, lines 57-67). However, Young does not specifically disclose that the control signal is generated from the external recording apparatus to the television signal receiving apparatus.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

Regarding claim 48, Young discloses a method of controlling a television signal receiving apparatus (Fig. 22A), comprising the steps of:

- sending information of a plurality of programs selectable by the television signal receiving apparatus to the television schedule system/tape controllers (232, 236, and 238 of Fig. 22A, col. 17, lines 37-67);

- selecting a program of the plurality of programs designated by a control signal sent from the television schedule system/tape (col. 17, lines 57-67); and

- sending a television signal of the selected program from the television signal receiving apparatus to the external recording apparatus (VCR 206 of Fig. 22A, col. 17, lines 57-67). However, Young does not specifically disclose that the control signal is generated from the external recording apparatus to the television signal receiving apparatus.

Young also discloses in col. 17, lines 21-25 that "It should be clear from these two systems 180 and 182 that the schedule/tape controller may be integrated into other television equipment, such as a cable decoder or a TV/Monitor receiver". Mankovitz additionally teaches that the G-code decoder can be embedded in the television receiver (Fig. 32, col. 33, lines 39-50) or in the VCR (Fig. 33, col. 33, lines 51-67) or in

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the cable box (Fig. 34, col. 34, lines 44-67) or in the satellite receiver (Fig. 35, lines 1-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of integrating the control unit of Young into the VCR as taught by Mankovitz in order to increase the flexibility of the system of Young by integrating the control unit of Young into other television equipment such as VCR, television receiver, cable box or satellite receiver.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

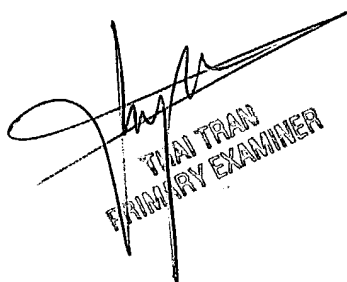
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



TAI TRAN  
PRIMARY EXAMINER